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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,264	12/08/2004	Andrea Mahn	4121-168	9836

7590 05/16/2006
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Intellectual Property Technology Law
PO Box 14329
Research Triangle Park, NC 27709

EXAMINER

WORLEY, CATHY KINGDON

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 05/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/500,264	Applicant(s) MAHN ET AL.	
	Examiner Cathy K. Worley	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 3, 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In the communication received on May 3, 2006, the Applicant has indicated they were not clear about what inventions were in group I and in group II. This second restriction requirement is being mailed to clarify the groups to facilitate election of an invention to be examined. The Examiner apologizes for the lack of clarity in the previous restriction requirement mailed on April 14, 2006.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

There are twenty-six thousand one hundred and twelve inventions, each of which is a unique combination of different elements (see lists of elements below). The 26,112 was calculated by multiplying $4 \times 2 \times 2 \times 3 \times 34 \times 2 \times 2 \times 4$, which are the number of choices for each element in lists a-h, below.

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Groups 1 – 26,112, claim(s) 1-19 (in part), drawn to a method of increasing the content of one or more transgene-coded biomolecules in an organism, the method comprising changing the distribution of ATP and/or ADP in cells of the organism; where in:

- a) the transgene is regulated in a specified manner: constitutive, temporally, locally, inducibly (4 choices)
- b) several transgene biomolecules are expressed in parallel or sequentially (2 choices)
- c) there is a specified host organism: plant or animal (2 choices)
- d) the transgene encodes a specified type of biomolecule: peptide, protein, or nucleic acid (3 choices)
- e) the transgene encodes a specified class of molecule: antibodies, aptamers, receptors, enzymes, growth factors, hormones, specific antigen, antibody molecules, interferons, immunoglobulins, growth hormones, insulin, collagen, plasminogen activator, blood factor I, blood factor II, blood factor III, blood factor IV, blood factor V, blood factor VI, blood factor VII, blood factor VIII, blood factor IX, blood factor X, blood factor XI, blood factor XII, histocompatibility antigens, enzymes, tumor marker proteins, viral proteins, ribozymes, single-stranded DNA, double-stranded DNA, single-stranded RNA, or double-stranded RNA (34 choices)
- f) subcellular distribution of ATP and/or ADP is either increased or reduced (2 choices)

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g) expression of a gene which codes for a protein involved in the subcellular distribution of ATP and/or ADP is either increased or decreased (2 choices)

and

h) the expression of a gene which codes for a protein involved in the subcellular distribution of ATP and/or ADP is constitutive or regulated temporally, locally, or inducibly (4 choices);

and wherein each of the groups 1 - 26,112 has a different combination of the items listed in parts a-h.

The inventions listed as Groups 1-26,112 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking groups 1-26,112 is a method comprising changing the distribution of ATP and/or ADP in the cells of an organism wherein the content of one or more transgene-coded biomolecules is increased. However, Tjaden et al. (The Plant Journal (1998) Vol. 16, pp. 531-540) teach altered ATP distribution (see page 533, Table 2) and teach increased content of AATP1 which is a transgene-coded biomolecule (see page 533, figure 2A). Therefore, the technical feature linking the inventions of groups 1-26,112 does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art.

Accordingly, groups 1-26,112 are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

Applicant is advised to select one item from each group (a-h). Any claims drawn to non-elected subject matter will be withdrawn from consideration.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if

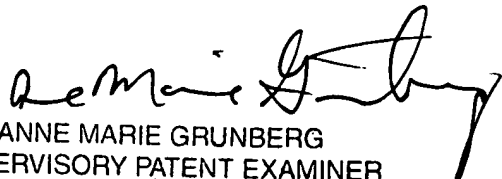
one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cathy K. Worley whose telephone number is (571) 272-8784. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CKW
May 5, 2006


ANNE MARIE GRUNBERG
SUPERVISORY PATENT EXAMINER